

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROSE MARY FARENDEN

Appeal 2007-2960
Application 09/800,069
Technology Center 3600

Decided: November 30, 2007

Before HUBERT C. LORIN, JENNIFER D. BAHR, and LINDA E. HORNER,
Administrative Patent Judges.

HORNER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-3 and 5-18, all the claims currently pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellant's claimed invention is directed to a web site for recruiting candidates for employment (Spec. 1:14-15). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A web site for recruiting candidates for employment, the site being programmed to:

receive input defining a candidate's employment credentials;

present at least one employment opportunity that best matches the candidate's employment credentials;

present an icon that is spawned upon the candidate's selection of the at least one employment opportunity for retaining the at least one employment opportunity wherein the candidate re-accesses the icon upon subsequent log-in;

receive input requesting consideration for the at least one employment opportunity that best matches the candidate's employment credentials; and

present the candidate with an invitation to an employer-hosted recruiting event based on a comparison between the candidate's employment credentials and candidate matching criteria associated with the at least one employment opportunity.

THE REJECTIONS

The Examiner relies upon the following evidence in the rejections:

Ferguson

US 5,966,697

Oct. 12, 1999

Joao

US 6,662,194 B1

Dec. 9 2003

Monster.com (Company Business and Marketing), PC Magazine, p. 170(1), May 25, 1999.

Monster.com Launch Marks Creation of World's Leading Global Online Network for Careers, Business Wire, p. 1133, Jan. 12, 1999.

The following rejections are before us for review.

1. Claims 1-3, 5, and 7-18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Joao and My Monster from Monster.com.
2. Claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Joao, My Monster, and Ferguson.¹

ISSUES

Appellant contends that the prior art fails to disclose (1) “an icon that is spawned upon the candidate’s selection of at least one employment opportunity... wherein the candidate re-accesses the icon upon subsequent log-in” as recited in claims 1 and 18 (Appeal Br. 4), (2) that employment opportunities may be applied for after they are retained as recited in claim 5 (*Id.*), and (3) that “the retained employment opportunities can also be deleted” as recited in claim 6 (*Id.*). The Examiner found that “My Monster from monster.com includes a password-protected area where members are able to store information concerning job searches, application histories, resumes, etc.” (Answer 4). The issue is whether the claimed invention requires that job opportunities be stored before the candidate applies for the job.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed.

¹ This rejection of claim 6 was added as a New Ground of Rejection in the Answer (Answer 2).

Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Joao discloses a method and apparatus for providing job searching services, recruitment services and/or recruitment related services in a network environment (Joao, col. 1, ll. 19-23).

2. The “my monster” feature of monster.com provides a password-protected area which functions like a career home page (Business Wire article, p. 2).

3. It enables job-seeking members, i.e., candidates, to manage their careers by creating and storing online resumes and cover letters, facilitating personalized job searches – even when the users are off-line, and tracking the progress of resume submissions ((Business Wire article, p. 2).

4. Monster.com’s job search agents report their progress daily, i.e., return potential job opportunities. Once a candidate finds a job they like, they can apply online using saved resumes or by sending an email. Candidates can also attach one of up to five cover letters (PC Magazine article, p. 1).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed

subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Graham v. John Deere Co.*, 383 U.S. at 17-18.

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739 (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court stated that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained,

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Id. at 1740-41. The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)

(“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

Rejection of claims 1-3, 5, and 7-18 as unpatentable over Joao, and My Monster

Appellant argues claims 1-3 and 7-18 as a group (Appeal Br. 3-5). As such, we select claim 1 as a representative claim, and the remaining claims of the group, i.e., 2, 3, and 7-18, stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007). We treat claim 5 separately, as discussed *infra*.

Claim 1 recites, *inter alia*, a web site for recruiting candidates for employment programmed to “present an icon² that is spawned upon the candidate’s selection of the at least one employment opportunity for retaining the at least one employment opportunity wherein the candidate re-accesses the icon upon subsequent log-in.” In rejecting claim 1, the Examiner found that “Joao teaches an online job search system but does not teach additionally comprising presenting an icon for retaining the at least one employment opportunity wherein the candidate re-accesses the icon upon subsequent log-in” and “My Monster from monster.com includes a password-protected area where members are able to store information concerning job searches, application histories, resumes, etc” (Answer 4). The

² We note that the Specification does not define the term icon. The Specification does refer to an “Add to job pod” button 453 which spawns a new browser window 445 containing a flash-based “job pod” 447. The job pod is an interactive multimedia tool used to manage job opportunities in which a candidate is interested (Specification 23:1-8 and 26-30). The customary meaning of an icon is a graphical representation, not an application or tool. Therefore, if prosecution of the present application continues, the Examiner may wish to consider whether the use of the term “icon” in claim 1 is vague because it’s unclear whether it refers to the “Add to job pod” link/icon 453 illustrated in Fig. 38 or the flash-based job pod browser window 445 containing job pod 447 illustrated in Fig. 40.

Examiner held that “[s]ince Joao teaches an online job search system wherein a candidate can enter search criteria it would have been obvious...to incorporate Monster’s ‘my monster’ feature wherein a user can store information concerning job searches in a password protected area of the website” in order to allow users to more quickly retrieve previous job searches, resumes, and the like. (*Id.*)

Appellant traverses the Examiner’s rejection based on the contention that “the ‘My Monster page’ requires that a person ‘apply’ for a job before it can be ‘tracked’” in contrast to the present invention which “only requires ‘selection’ of an employment opportunity for the opportunity to be ‘retained’ for future reference” (Appeal Br. 3-4). Appellant further contends that “the My Monster page does not retain ‘job searches’ – it only retains previous job applications” (Appeal Br. 4). We disagree.

The “my monster” feature of monster.com provides a password-protected area which functions like a career home page (Finding of Fact 2). It enables job-seeking members, i.e., candidates, to manage their careers by creating and storing online resumes and cover letters, facilitating personalized job searches – even when the users are off-line, and tracking the progress of resume submissions (Finding of Fact 3). Furthermore, the Monster.com job agents report their progress i.e., job searches, daily (Finding of Fact 4). As such, we find Appellant’s assertion that My Monster *only* retains previous job applications unpersuasive. Furthermore, even if, *arguendo*, My Monster did only retain previous job applications, retention of the applications is still initiated by selection of a job opportunity, which is all that is required by claim 1.

Appellant further contends that “the claimed invention enables employment opportunities to be applied for *after* they are retained” in as much as claim 5 recites “wherein the icon is configured to receive input requesting consideration for the at least one retained employment opportunity” (Appeal Br. 4) (emphasis in original). We disagree.

Claim 5 does not require that the employment opportunity be applied for after it is retained as suggested by Appellant. On the contrary, claim 5 only requires that the icon, which is spawned upon selection of an opportunity, be configured to receive a request for consideration of a stored opportunity. My Monster teaches selecting one of a plurality of stored cover letters when applying for the opportunity, which corresponds to receiving an input requesting consideration for the at least one retained employment opportunity as claimed (Finding of Fact 4). As such, we sustain the Examiner’s rejection of claims 1-3, 5, and 7-18 as unpatentable over Joao and My Monster.

Rejection of claim 6 as unpatentable over Joao, My Monster, and Fergerson

Claim 6, which depends from independent claim 1, further recites the icon is configured to receive input for selecting and deleting a retained employment opportunity. In rejecting claim 6, the Examiner took Official Notice that it is old and well known in the art to select and deselect results of a query (Answer 6). Furthermore, the Examiner held that “[s]ince Joao and Monster.com teach a user performing a search based on specific criteria and subsequently viewing and select[ing] results, it would have been obvious...to incorporate the deletion feature

to facilitate deletion of any stored job opportunity” which did not come to fruition (*Id.*).

Appellant presents various concusory statements in the Reply Brief regarding the Examiner’s rejection, but doesn’t provide any support for the concusory statements. More specifically, Appellant contends that “[t]he Examiner has improperly taken Official Notice of ‘select[ing] and deselect[ing] results of a query” (Reply Br. 2), but doesn’t explain why it is improper. It appears from the quotation in Appellant’s reply brief that Appellant is arguing that the Examiner needs to provide a reference to support the Official Notice. However, the Examiner did provide a reference (i.e., Ferguson) to support the Official Notice.

Appellant further contends that “‘shopping’ is not analogous art” and that “[t]he Examiner’s mere assertion that ‘shopping’ is analogous prior art does not provide the necessary motivation to combine the references with the substance of the Examiner’s improper Official Notice” (Reply Br. 2-3). However, Appellant does not address why shopping is not analogous prior art or why the Examiner erred in holding that it would have been obvious to incorporate the deletion feature to enable the user to keep a more efficient and up-to-date record of pending jobs.

Finally, Appellant contends that “Joao teaches away from the proposed combination, as explained in Applicant’s Appeal Brief” (Reply Br. 3). However, we are unable to find any assertions in Appellant’s Appeal Brief regarding the “teaching away” of Joao. As such, we sustain the Examiner’s rejection of claim 6.

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CONCLUSIONS OF LAW

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 1-3, 5, and 7-18 as unpatentable over Joao and My Monster and claim 6 as unpatentable over Joao, My Monster, and Ferguson.

DECISION

The Examiner's decision to reject claims 1-3 and 5-18 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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